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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,179	01/05/2006	Terence Arnold Waldoek	THOM-0040	8320
23377 7590 01/13/2011 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER				
WEBB, SARAH K				
ART UNIT		PAPER NUMBER		
3731				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

eoofficemonitor@woodcock.com

Office Action Summary

Application No.

10/523,179

Applicant(s)

WALDOCK ET AL.

Examiner

SARAH WEBB

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-52,54-58,61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) 9,11-14,20-52 and 54-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,8,10,15-19,61 and 62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/28/2010 have been fully considered but they are not persuasive. Applicant's arguments are directed towards the claimed function and fail to point out structural deficiencies of the prior art. Applicant argues that the Cummings references perform the function of folding the lens instead of rolling the lens as claimed. The phrase "for rolling" is a functional recitation that is not given full patentable weight. As long as the prior art discloses all the claimed structures and the capability of performing the functions, it meets the claims. In this case, both Cummings references include all the claimed structural features and are capable of performing the function of rolling the lens into a compression configuration.

Examiner asserts that both references disclose the act of rolling the lens. Cumming '708 clearly illustrates the IOL (16) engaging the curved surface (20) in Figure 11A to "roll" into a compressed configuration shown in Figure 11B. Applicant's choice in different terminology describing this function fails to overcome the disclosure of Cumming '708.

Although the Cumming '275 disclosure describes "folding" the lens in column 6, lines 28-45, Cumming '275 also discloses the function of "rolling" the lens by its engagement with the curved surface (48) in Figures 20 and 21. Applicant's choice in different terminology describing this function fails to overcome the disclosure of Cumming '275.

Claim Objections

2. Claim 62 is objected to because of the following informalities: it is dependent upon cancelled claim 59. For the purposes of expediting prosecution, the claim was examined based upon its dependency from claim 61. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5, 7, 8, 10, 15, 61, and 62 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,497,708 to Cumming.

Cumming '708 discloses a device (12) for rolling an ophthalmic lens (16) that includes two members that slide relative to one another. The first member (18) is adapted to receive and locate the lens (16) within a concave recess (20), as shown in Figure 11a. The second member (32) also has a concave recess that engages the lens and causes it to roll as it slides relative to the first member (see Figure 11B). The second member (32) has an abutment surface (33) formed by a land that extends along the edge of the concave recess. As illustrated in Figure 11B, the abutment (33) that limits the movement of the lens (16) in a rotational direction and causes it to roll.

Regarding claim 8, the top of the second member has an outwardly extending flange, or stop, that engages the first member to define the limit position. In regards to

claim 15, this stop is capable of providing indication to the operator that the members are in the relative position of Figure 11B, wherein rolling has been achieved.

Regarding claim 10, Figure 1 illustrates the construction of the two sliding members that include various interlocking features to constrain the members to slide rectilinearly relative to each other.

Regarding claims 61 and 62, the radius of curvature of the concave surface (38) of element (32) is different than the radius of curvature of the concave surface (20). The abutment is formed along an edge of the recess (38) of member (32). It forms a step between the surfaces (20 and 38) in the limited position of Figure 11B.

4. Claims 1, 3, 5, 8, 10, and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,503,275 to Cumming.

Cumming '275 discloses a device (22) for rolling an ophthalmic lens (16) that includes two members that slide relative to one another. The first member (22) is adapted to receive and locate the lens (16) within a concave recess (32), as best shown in Figure 10. The second member (36) has a concave recess at one end that engages the lens (16) and causes it to roll as it slides relative to the first member. Figure 11 illustrates the limit position in which the lens is rolled and an outwardly extending flange, or stop, on the top of the second member (36) engages the first member (22).

Regarding claim 8, the top of the second member has an outwardly extending flange, or stop, that engages the first member to define the limit position. In regards to

claim 15, this stop is capable of providing indication to the operator that the members are in the relative position of Figure 11B, wherein rolling has been achieved.

Regarding claim 10, Figure 25 illustrates the construction of the two sliding members that include various interlocking features to constrain the members to slide rectilinearly relative to each other.

Regarding claims 15-17, the second member includes a resilient biasing means in the form of flexible arms (50) that maintain the sliding members in a spaced position to allow the lens to be stored in the position shown in Figure 6 (column 6, lines 21-26). The second member also includes a "click-stop mechanism" that includes flexible strips (prongs 52) projecting from its sides that engage behind abutment surfaces (notches 60) on the first member, as shown in Figure 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming ('275) in view of US Patent No. 5,944,725 to Cicenias et al.

Regarding claim 4, Cumming ('275) fails to form the recesses of the sliding members as "step portions" between two parallel surfaces. Cicenias discloses another device for preparing an ophthalmic lens for insertion that includes two members that

slide relative to one another to position the lens. Cicenias teaches that both members (40,42) can be configured to have step portions with concave recesses formed between two parallel surfaces to engage the lens (12), as best shown in Figures 6A-C. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form both the first and second members of the Cumming ('275) device to have step portions between two parallel surfaces to engage the lens, as taught by Cicenias, as this is simply another way to form two members that slide relative to one another to position an ophthalmic lens in a compressed configuration for insertion.

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cumming ('275) in view of US Pat. No. 6,007,542 to Duprat.

Cumming ('275) fails to form the biasing means as an arcuate member with ends that engage the other member. Duprat discloses a device that includes two members disposed in a sliding relationship with one another, each including a recess, and configured to roll an ophthalmic lens. The members receive and locate the lens, as illustrated in Figure 6, and relative movement of the members causes the lens to roll up into the configuration shown in Figure 8. Duprat teaches that the biasing means can be in the form of springy arcuate members (15, 16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the biasing means of Duprat as springy arcuate members, as Duprat teaches that this is another way to form a means for biasing two sliding components of a lens rolling device away from one another.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH WEBB whose telephone number is (571) 272-5749. The examiner can normally be reached on 9:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. W./
Examiner, Art Unit 3731

/TODD E. MANAHAN/
Supervisory Patent Examiner, Art Unit 3776